



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Faull *et al.*

Serial No: 09/889,516

Filed: October 2, 2001

For: Chemical Compounds

Attorney Docket No. ASZD-P01-470

Art Unit: 1625

Examiner: Binta M. Robinson

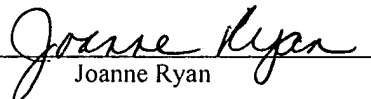
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CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

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July 28, 2003

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and of Mail Deposit


Joanne Ryan

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY TO RESTRICTION REQUIREMENT

Sir:

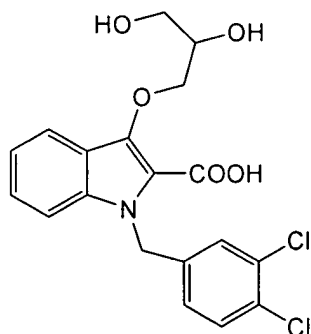
In reply to the outstanding Restriction Requirement, mailed July 1, 2003, in connection with the above application, Applicants hereby elect with traverse Group I, claims 1-10, drawn to the compound of formula I where X is CH₂ and R¹ through R¹⁸ are defined as set out in the Restriction Requirement. Applicants elect this invention with traverse, because unity of invention exists with respect to the invention divided into three groups by the Examiner.

Applicants respectfully direct the Examiner's attention to 37 C.F.R. 1.499 which states that "[i]f the examiner finds that a national stage application lacks unity of invention under § 1.475, the examiner may require the applicant . . . to elect the invention to which the claims shall be restricted." For guidance on unity of invention of Markush claims, Applicants respectfully direct the Examiner's attention to the Administrative Instructions under the PCT, Annex B, Example 18. Example 18 sets out a claim to a compound having an indolyl moiety with four substituent groups, R¹-R⁴. The compounds are useful as pharmaceuticals for enhancing the

capacity of blood to absorb oxygen. Example 18 concludes that unity of invention is present as “the indolyl moiety is the significant structural element which is shared by all of the alternatives” and “all the claimed compounds are alleged to possess the same utility.”

Applicants respectfully submit that the situation presented in Example 18 is very similar to the present case. The claimed compounds include an indolyl moiety as “the significant structural element which is shared by all of the alternatives” and are alleged to possess the same utility of inhibiting an MCP-1 (Monocyte Chemoattractant Protein-1) or RANTES (Regulated upon Activation, Normal T-cell Expressed and Secreted) induced chemotaxis. Accordingly, unity of invention is present in the current claims and a requirement to restrict is improper.

In response to the requirement that Applicants elect a single disclosed species, Applicants elect compound 71 with traverse and for search purposes only.



Compound 71

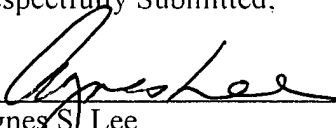
Applicants note with appreciation that claims 1-11 [sic] are considered generic claims linking elected and non-elected species. Pursuant to MPEP 809.04, “[i]f a linking claim is allowed, the examiner must thereafter examine species if the linking claim is generic thereto, or he or she must examine the claims to the non-elected inventions that are linked to the elected invention by such allowed linking claim.” Thus, restrictions imposed on species encompassed by generic claims must be withdrawn upon indication of an allowable generic claim (MPEP 809). In other words, upon the allowance of a generic claim, Applicants are entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141 (MPEP 809.02(a)).

The Examiner may address any questions raised by this submission to the undersigned at 617-951-7000. Should an extension of time be required, Applicants hereby petition for same and request that the extension fee and any other fee required for timely consideration of this submission be charged to **Deposit Account No. 18-1945**.

Date: July 28, 2003

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Respectfully Submitted,



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